



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/247,054	02/09/1999	MICHAEL ANTONIOU	CACO-0045	7091

7590

11/01/2002

WOODCOCK WASHBURN KURTZ  
MACKIEWICZ AND NORRIS  
ONE LIBERTY PLACE  
46TH FLOOR  
PHILADELPHIA, PA 19103

EXAMINER

FALK, ANNE MARIE

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 11/01/2002

32

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/247,054

Applicant(s)

ANTONIOU ET AL.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

**--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
 2. ☒ The proposed amendment(s) will not be entered because:  
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ they raise the issue of new matter (see Note below);  
 (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 3-21, 23 and 25.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
 10. ☐ Other: \_\_\_\_\_

*Anne-Marie Falk*  
 ANNE-MARIE BAKER  
 PATENT EXAMINER

Art Unit: 1632

**Continuation Sheet (PTO-303)****Continuation of 2. NOTE:**

The proposed claim amendments, if entered, would require numerous new grounds of rejection under 35 U.S.C. 112, first paragraph, 35 U.S.C. 112, second paragraph, and 35 U.S.C. 103(a). For example, Claims 50 and 51 would be subject to a new ground of rejection under 35 U.S.C. 112, first paragraph, for failure to provide an enabling disclosure. See, for example, the rejection of Claim 22 in the Office Action of Paper No. 5 (mailed 7/9/99). As another example, Claim 39 and claims dependent therefrom would be subject to a new rejection under 35 U.S.C. 112, second paragraph, as being indefinite in its recitation of "said origin of replication" because the phrase has ambiguous antecedent basis, as the claim recites "a first vector comprising ... an origin of replication" and "a second vector comprising ... an origin of replication" and there is no requirement that these two origins of replication be the same. Furthermore, Claim 39 recites "i)" twice. As another example, Claim 52 would be subject to a new rejection under 35 U.S.C. 112, second paragraph, as being indefinite in its recitation of "obtaining persistent, tissue-specific expression of a gene of interest" because the vector does not comprise a "gene of interest." Numerous other rejections would be applied to the newly proposed claims.

**Continuation of 5. does NOT place the application in condition for allowance because:**

the arguments presented are directed to the newly proposed claims, but the proposed claims have not been entered. All rejections are maintained for reasons of record.